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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,037	06/05/2000	J. Gregory Stout	A-68146/MAK/LM	8559

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/588,037

Applicant(s)

Stout

Examiner
Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 3, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-8 are presented for examination. Applicant filed an amendment on 1/3/2003 amending claims 1-8. Applicant's amendment of claims 1-8 necessitated a new search for prior art by the Examiner. New grounds of rejection of claims 1-8 based on 35 USC 103 are established in the instant application as set forth in detail below.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Applicant claims priority to Application Serial Number 08/853,955. However, the declaration fails to claim the benefit under 35 USC 120 of Application Serial Number 08/853,955. Therefore, for

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purposes of examination of the claims, the Examiner will apply the priority date of the 08/957,757 application to the instant application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al., Pat. No. 5,642,485 (hereinafter Deaton) in view of Kepecs, Pat. No. 6,009,411 and Biorge et al., Pat. No. 5,806,045 (hereinafter Biorge).

As to claim 1, Deaton discloses a method for storing and retrieving consumer transaction information (see abstract), the method comprising the following steps:

during a first transaction by a consumer at a first merchant, capturing transaction information (i.e. the system contains a database which contains relevant information about the frequency of the customer's transactions, the amount of the transaction ...)(col. 59, lines 54-60 and col. 61, line 49 - col. 62, line 52).

storing captured said transaction information on a server (i.e. transaction processor 112)(see Fig. 1 and col. 11, lines 4-17).

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Deaton does not explicitly disclose
applying captured said transaction information to a second transaction involving said
consumer at a second merchant.

However, Kepecs discloses applying that captured transaction information to a transaction
involving the consumer at a second merchant (i.e. master stores 23 ... criterion fields can be
matched by the past purchasing patterns of consumers ... match customer, criteria, and discount
information ... database contains information on the particular retailers who stock each of the
discounted items)(see Fig. 3, col. 8, lines 29-46 and line 64 - col. 9, line 5). It would have been
obvious to one of ordinary skill in the art at the time of Applicant's invention to include applying
captured said transaction information to a second transaction involving said consumer at a second
merchant as disclosed by Kepecs within the Deaton method for the motivation of providing a
customer discount choices of items available in a collection of stores over a network (col. 2, lines
40-48).

Deaton and Kepecs do not explicitly disclose
applying captured said transaction information at the second merchant not required to be
associated with said first merchant.

However, Biorge discloses applying captured said transaction information at the second
merchant not required to be associated with said first merchant (after incentive credits are earned
they may be redeemed in a subsequent transaction with a participating provider)(col. 6, line 32 -
col. 7, line 13). It would have been obvious to one of ordinary skill in the art at the time of

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Applicant's invention to include applying captured said transaction information at the second merchant not required to be associated with said first merchant as disclosed by Biorge within the Deaton and Kepecs method for the motivation of providing an effective incentive program by giving consumers a large number of choices with regards to products and services from a large number of different providers (col. 1, lines 13-37).

As to claim 2, Deaton does not explicitly disclose the method of claim 1, further including prior to step c a step of

identifying the consumer in a transaction at the second merchant.

However, Kepecs discloses identifying the consumer in a transaction at the second merchant (i.e. Customer_No)(col. 10, lines 5-18). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include identifying the consumer in a transaction at the second merchant as disclosed by Kepecs within the Deaton, Kepecs and Biorge method for the motivation of permitting the customer to track his or her total consumption history (col. 2, lines 11-19).

As to claim 3, Deaton does not explicitly disclose the method of claim 1, further including prior to step c a step of wherein before the step of applying, the following step is performed

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communicatively coupling the first and second merchants and the server by means of an internet.

However, Kepecs discloses communicatively coupling the first and second merchants and the server by means of an internet (Fig. 1 and Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include communicatively coupling the first and second merchants and the server by means of an internet as disclosed by Kepecs within the Deaton, Kepecs and Biorge method for the motivation of permitting the customer to track his or her total consumption history (col. 2, lines 11-19).

As to claim 4, Deaton discloses the method of claim 1, further including prior to step c a step of wherein the step of capturing comprises capturing consumer information at the first merchant (i.e. the system contains a database which contains relevant information about the frequency of the customer's transactions, the amount of the transaction ...)(col. 59, lines 54-60 and col. 61, line 49 - col. 62, line 52).

As to claim 5, Deaton discloses the method of claim 1, during step a includes capturing consumer loyalty information at the first merchant (i.e. frequency of customer's transactions)(col. 59, lines 54-60).

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As to claim 6, Deaton does not explicitly disclose the method of claim 1, wherein step B includes storing the captured selection information on a server external to the first merchant.

However, Kepecs discloses the step of storing comprises storing the captured selection information on a server external to the first merchant (i.e. DAP and DAP Internet Server)(Fig. 1 and Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the step of storing comprises storing the captured selection information on a server external to the first merchant as disclosed by Kepecs within the Deaton, Kepecs and Biorge method for the motivation of permitting the customer to track his or her total consumption history (col. 2, lines 11-19).

As to claim 7, Deaton discloses the method of claim 1, wherein step b includes forwarding the captured selection information to the server (i.e. transaction processor 112)((see Fig. 1 and col. 11, lines 4-17).

As to claim 8, Deaton does not explicitly disclose the method of claim 1, wherein the step c includes

applying that captured transaction information to a transaction involving the consumer at a second merchant and initiated by a browser on a personal computer connected to the internet.

However, Kepecs discloses applying that captured transaction information to a transaction involving the consumer at a second merchant and initiated by a browser on a personal computer

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connected to the internet (i.e. consumers use their computers 10 for connection to the computer 11 of the DAP through the internet(col. 4, lines 31-47 and col. 9, lines 31-44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include applying that captured transaction information to a transaction involving the consumer at a second merchant and initiated by a browser on a personal computer connected to the internet as disclosed by Kepecs within the Deaton, Kepecs and Borge method for the motivation of providing a customer discount choices of items available in a collection of stores over a network (col. 2, lines 40-48).

Response to arguments

5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendments to claims 1-8 necessitated a new search for prior art by the Examiner. Applicant's amendment to claims 1-8 contain new limitations not found in the originally filed claims 1-8. Newly found prior^{art} was used to establish new grounds of rejection of claims 1-8 based on 35 USC 103. The Examiner refers Applicant to the detailed rejection of claims 1-8 in the next section above.

6. With respect to Applicant's arguments directed to the objection to the Declaration, Applicant argues that the originally filed Declaration is not defective. The Examiner disagrees. The Applicant did not address the Examiner's observation that the Declaration failed to mention any priority to the 08/853,955 application even though, as pointed out by Applicant, the

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specification contains a statement claiming continuation in part priority to 08/853,955 priority. A discrepancy exists between the priority cited in the specification and the priority claimed in the Declaration. It is this discrepancy that was pointed out by the Examiner. Any claims to priority documents that Applicant wishes to claim for the instant application must be claimed properly in the declaration. Any continuation in part priority documents must be listed in the declaration under the benefit of 35 USC 120 (see MPEP 201.08 and MPEP 602.03). Furthermore, the Examiner notes that Applicant claimed priority to two provisional applications under the benefit of 35 USC 120. However, to claim benefit to the provisional applications, Applicant must claim priority to the provisional applications under the benefit of 35 USC 119(e).(see MPEP 201.04(b)). Therefore, the Examiner maintains the objection to the specification.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

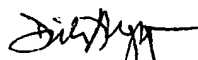
If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

Alexander Kalinowski



February 22, 2003


DINH X. NGUYEN
PRIMARY EXAMINER